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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/803,056 | 03/18/2004 | Keiichi Nakajima | 007874-0308355 | 4628 |
| 909 | 7590 | 06/06/2005 | EXAMINER | |
| PILLSBURY WINTHROP SHAW PITTMAN, LLP | | | ST CYR, DANIEL | |
| P.O. BOX 10500 | | | ART UNIT | |
| MCLEAN, VA 22102 | | | PAPER NUMBER | |
| | | | 2876 | |

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/803,056 | Applicant(s) NAKAJIMA, KEIICHI | |
| | Examiner Daniel St.Cyr | Art Unit 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☐ Claim(s) _____ is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 09 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, drawn to funds transfer, classified in class 235, subclass 379.
 - II. Claims 18-21, drawn to an adapter for toll charging system, classified in class 455, subclass 406.
2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as toll collecting. See MPEP § 806.05(d).
3. The inventions have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. A telephone call was made to Benjamin Kiersz on 5/31/05 to request an oral election to the above restriction requirement, but did not result in an election being made.

Remark

5. The examiner has elected to examine claims 1-17. **However, the applicant still reserves the right to elect either group I of claims 1-17 or group II of claims 18-22.**

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-5, 8-11, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosen, US Patent No. 5,949,044.

Rosen discloses a trusted agents for open distribution of electronic money: a payment terminal 4 operable to store a first balance of electronic money for said electronic money payment relating to a dealing; a demanding terminal 2 operable to communicate with said payment terminal to demand said payment; and a payment apparatus (MTD) 2 operable to communicate with said demanding terminal and to store a second balance of electronic money to correspond to an identification number of said payment terminal for validating said payment, wherein said demanding terminal receives from said payment terminal said first balance stored in said payment terminal and transmits said first balance to said payment apparatus, and said payment apparatus detects unfair use of said electronic money by checking said first balance stored in said payment terminal, which was received from said demanding terminal, with said second balance stored in said payment apparatus (see figures 1-4, and col. 17, lines 7-20).

Re claim 4, wherein in a case where said communication unit received from said payment terminal a deposit-requested amount of said electronic money, said processor updates said check balance stored in said memory unit based on said deposit-requested amount, and said communication unit transmits a new balance, obtained by said update, to said payment terminal (inherently once a transfer is made from one account to another, both accounts are updated to reflect the transferred amount).

Re claims 7, 8, wherein, in a case where said communication unit received a balance inquiry request from said payment terminal together with the electronic money balance for making payment on the dealing, said processor compares said electronic money balance said

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communication unit received from said payment terminal with said check balance stored in said memory unit, and transmits a warning indicating a possibility of unfair use when said compared balances do not coincide (see col. 17, lines 7-20).

Re claims 8-11 and 13-15, the limitations have been met above.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,796,491 (hereinafter '491 Patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are somehow broader than the '491 Patent. For instance, in claim 2 of the instant application and the 491 Patent, the applicant claims:

i)"A payment apparatus that communicates with a payment terminal and a demanding terminal to make settlement on an electronic money payment for a dealing, the payment terminal being operable to store an electronic money balance for making payment on the dealing by the electronic money, the demanding terminal being operable to demand the

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payment on the dealing, the payment apparatus comprising: a memory unit operable to store a check balance of said electronic money to correspond to an identification number of said payment terminal; a communication unit operable to receive, from said demanding terminal, a payment amount of said electronic money to be paid by said payment terminal; and a processor operable to update said check balance of said electronic money stored in said memory unit based on said payment amount received from said demanding terminal.”

Wherein in the ‘491 patent, the applicant claims:

ii)” A payment apparatus that communicates with a payment terminal and a demanding terminal to make settlement on an electronic money payment for a dealing, the payment terminal being operable to store an electronic money balance for making payment on the dealing by the electronic money, the demanding terminal being operable to demand the payment on the dealing, the payment apparatus comprising: a memory unit operable to store a check balance of said electronic money to correspond to an identification number of said payment terminal; a communication unit operable to receive, from said demanding terminal, a payment amount of said electronic money to be paid by said payment terminal; and a processor operable to update said check balance of said electronic money stored in said memory unit based on said payment amount received from said demanding terminal, wherein, in a case where said communication unit received from said payment terminal a deposit-requested amount of said electronic money, said processor updates said check balance stored in said memory unit based on said deposit-requested amount, and said communication unit transmits a new balance, obtained by said update, to said payment terminal, wherein said communication unit receives the electronic money balance for making payment on the dealing, when said

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deposit-requested amount of said electronic money is received from said payment terminal, and said processor compares said electronic money balance said communication unit received from said payment terminal with said check balance stored in said memory unit, transmits said new balance to said communication unit when said compared balances coincide, and notifies a manager of said payment apparatus of a warning indicating a possibility of unfair use when said compared balances do not coincide.”

Thus, in respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teaching of claims 1-23 of ‘491 Patent as a general teaching for an electronic payment system, to perform the same function as claimed in the present invention. The instant claims obviously encompass the claimed invention of the ‘491 Patent and differ only in terminology. The extent that the instant claims are broadened and therefore generic to claimed invention of ‘491 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from the claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. & 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. & 1.78(d).

Allowable Subject Matter

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10. Claims 6, 7, 12, 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and upon filing of a terminal disclaimer.

11. The following is a statement of reasons for the indication of allowable subject matter:

Although the prior art teaches an electronic payment system that stores the amount of the electronic money in a first device wherein the first device transmits the amount of the electronic money to a second device, the second device compares the amount sent with an amount store in the second device to determine unfair use of the electronic money, the prior art of record fails to disclose or fairly suggests all the detailed steps including updating a first and a second reference number in accordance with predetermined rules then checking the first and the second updated reference numbers to determine unfair use. These limitations in conjunction with the limitations in the claims were not shown by the prior art of record.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr

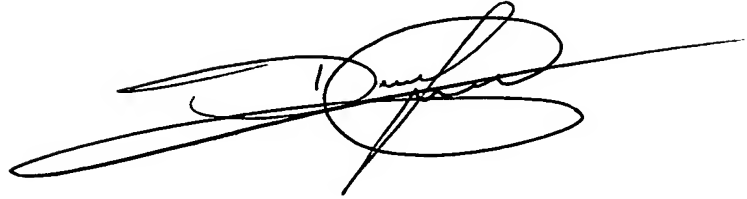
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Primary Examiner
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DS
June 2, 2005

A handwritten signature in black ink, consisting of several loops and a long horizontal stroke extending to the right.